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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,984	06/08/2001	Qingping Chen	618-999	9954

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1155 AVENUE OF THE AMERICAS
NEW YORK, NY 100362711

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/876,984

Applicant(s)

CHEN ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The new grounds of rejection as set forth in paragraphs 2-4 below are necessitated by applicants' amendment filed 3/24/03 and thus, the following action is final.

Claim Objections

2. Claims 12-13 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 12, which depends on claim 1, recites that the ink comprises organic solvent in the amount "from about 1 to about 90 weight percent of the ink composition" while claim 1 recites that the ink is "organic solvent based". Thus, claim 12 fails to further limit the scope of the claim on which it depends, claim 1, given that claim 12 encompasses inks which only comprise, for instance, 1% organic solvent which is clearly not an organic solvent based ink. While claim 1 is limited to "organic solvent based" inks, claim 12 is clearly open to both "organic solvent based" inks as well as inks which are not organic solvent based.

Similar objections also arise with respect to claim 13, which depends on claim 12 and thus, ultimately on claim 1, and which recites that the ink comprises organic solvent in the amount "from about 10 to about 65 weight percent of the ink composition" and thus, fails to further limit the scope of claim 1.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12, which depends on claim 1, recites that the ink comprises organic solvent in the amount “from about 1 to about 90 weight percent of the ink composition” while claim 1 recites that the ink is “organic solvent based”. Thus, the scope of claim 12 is confusing because it is not clear how an “organic solvent based” ink can comprise the low amounts of organic solvent as recited in claim 12, i.e. 1%, 2%, etc. It is not clear how the ink can contain, for instance, only 1% organic solvent and still be considered an organic solvent based ink. Clarification is requested. Further, what does “organic solvent based” mean? Does this mean that the ink comprises primarily organic solvent, i.e. >50%, that the ink comprises only organic solvent, or that the ink can comprise both organic solvent and water as long as the water is present in smaller amounts than the organic solvent?

Similar questions arise in claim 13, which also recites specific amounts of organic solvent.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-13, 16-23, 26-28, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (U.S. 6,387,984) in view of Cook (U.S. 4,146,699).

The rejection is adequately set forth in paragraph 3 of the office action mailed 1/7/03, Paper No. 6, and is incorporated here by reference.

7. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in view of Cook as applied to claims 1-13, 16-23, 26-28, and 36 above, and further in view of Gajria et al. (U.S. 4,686,246).

The rejection is adequately set forth in paragraph 4 of the office action mailed 1/7/03, Paper No. 6, and is incorporated here by reference.

8. Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in view of Cook as applied to claims 1-13, 16-23, 26-28, and 36 above, and further in view of Yatake (U.S. 6,454,846).

The rejection is adequately set forth in paragraph 5 of the office action mailed 1/7/03, Paper No. 6, and is incorporated here by reference.

9. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (U.S. 6,387,984) in view of Cook (U.S. 4,146,699) and either Yamamoto et al. (U.S. 5,059,246) or Kramer et al. (U.S. 4,077,807).

The rejection is adequately set forth in paragraph 6 of the office action mailed 1/7/03, Paper No. 6, and is incorporated here by reference.

10. Claims 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (U.S. 6,387,984) in view of Cook (U.S. 4,146,699) and Enami (U.S. 4,471,079).

The rejection is adequately set forth in paragraph 7 of the office action mailed 1/7/03, Paper No. 6, and is incorporated here by reference.

Response to Arguments

11. Applicants' arguments filed 3/24/03 have been fully considered but they are not persuasive.

Specifically, applicants argue that Ito et al. is no longer a relevant reference against the present claims given that Ito et al. is drawn to an aqueous-based ink while the present claims are drawn to an organic solvent based ink.

However, it is noted that while Ito et al. refers to the ink as an aqueous ink, there is no disclosure that the ink is aqueous-based. That is, col.8, lines 30-33 of Ito et al. disclose that the ink contains water in an amount of 1-80%. If the ink contains only 1% water, such ink would not be considered "aqueous-based". Further, col.8, lines 10-12 of Ito et al. disclose that the ink

comprises 1-40% organic solvent. Thus, if the ink of Ito et al. comprises only 1% water but 40% organic solvent, it is clear that the ink would be considered organic solvent based as opposed to aqueous-based given that the ink comprises primarily organic solvent as opposed to water.

While it is noted that there is no disclosure of water in the present claims, in light of the open language of the present claims, i.e. "comprising", it is clear that the present claims are open to the inclusion of additional ingredients including water. That is, an ink can be considered organic solvent based but still comprise small amounts of water.

Thus, given that Ito et al. disclose ink which comprises small amounts of water and larger amounts of organic solvent, it is the examiner's position that Ito et al. remains a relevant reference against the present claims.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Callie Shosho
May 29, 2003


VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700